

REMARKS

I. Preliminary Remarks

In a response mailed September 20, 2002 and apparently received in the U.S. Patent and Trademark Office on December 20, 2002, the applicants addressed the restriction requirement imposed in Paper 7 by electing claims 1-19 and 30-31 of Group I. Further, the applicants elected the species of "glucocorticoid" and the species of "incorporating molecules." The elections were made with traverse.

II. Further Requirement for Restriction

In the Office Action, the Examiner asserted that "applicant's response to the restriction/election requirement did not include an election of a single/specifically disclosed species from under the elected Group as requested (i.e., a single compound which names or identifies a specific glucocorticoid, linking group and incorporating molecule as exemplified by the specification)." Office Action at page 2. The Examiner then noted that the applicants are required to identify a single disclosed compound from under the elected Group.

III. Election

Consistent with the Examiner's requirements, the applicants hereby elect the glucocorticoid species of "dexamethasone," *with traverse*. Claims 1-19 and 30-31 are readable on this species. Also, the applicants hereby elect the incorporating molecule species of "psoralen," *with traverse*. Claims 1-19 and 30-31 are readable on this species.

III. Traversal of Restriction Requirement

The Examiner asserted that the applicants' response of December 20, 2002, was not fully responsive to the prior Office Action (Paper 7) insofar as the response did not include an election of a specific glucocorticoid species and a specific incorporating molecule species. The applicants respectfully disagree.

The prior Office Action imposed a four-way restriction requirement and further required an election of species for the Markush groups recited in claims 12 and 13 of Group I. In particular, the prior Office Action recited that "Claims 1-19 and 30-31 are generic to a plurality of disclosed patentably distinct species comprising: **A specifically**

named steroid hormone as listed in the Markush group of claim 12. Paper 7 at page 4 (emphasis in original). Analogously, that prior Office Action recited that those same claims are generic to "a plurality of disclosed patentably distinct species comprising: **A specifically named DNA interacting molecule as listed in the Markush group of claim 13.**" *Id.* (Emphasis in original.) These quoted statements establish that the "species" that must be elected are the species as listed in the respective Markush groups.

The Markush group of claim 12 recites "androgens, gestagens, oestrogens, glucocorticoids, mineralcorticoids, retinoids, thyroids and synthetic steroids." In applicants' response of December 20, 2002, "glucocorticoids" was elected with traverse. The Markush group of claim 13 recites "intercalating agents, crosslinking reagents, incorporating molecules and ionically interacting molecules." In that same response, applicants elected "incorporating molecules" with traverse. Thus, applicants elected specifically named species as listed in the respective Markush groups. Accordingly, applicants' response of December 20, 2002 was fully responsive to the prior Office Action.

In addition, the outstanding Office Action dated February 24, 2003, is imposing a requirement that applicants elect a single, specifically disclosed species from the elected Group in the form of "a single compound which names or identifies a specific glucocorticoid, linking group and incorporating molecule." These specific compounds are *not* listed members of the Markush groups of claims 12 and 13, although such compounds are embraced by the Markush groups. The prior Office Action did not impose a requirement that applicants elect such specific compounds. In effect, the patent office is impermissibly redrafting the applicants' claims. The applicants submit that there is no basis for such action in the patent statutes, the rules, or the Manual of Patent Examining Procedure. Moreover, the outstanding Office Action provided, as its sole basis for requiring an election of particular compounds, the misplaced assertion that the applicants had not fully responded to the prior Office Action. Because applicants had fully responded to the prior Office Action, as established above, and because there is no other basis upon which to require election of particular compounds, the applicants submit that a *prima facie* case in support of further restricting the claims of Group I has not been established and the requirement may properly be withdrawn.


CONCLUSION

For the foregoing reasons, the applicants submit that the election, with traverse, of claims 1-19 and 30-31 of Group I, and the further election, with traverse, of "glucocorticoids" and "incorporating molecules" as species of the Markush groups of claims 12 and 13, respectively, has placed the claims in condition for examination. Accordingly, the requirement to elect specific compounds (e.g., dexamethasone as a specific glucocorticoid and psoralen as a specific incorporating molecule) has been overcome and should be withdrawn.

Respectfully submitted,

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